

REMARKS

By this Amendment, Applicant cancels claims 2-4 and 6-8 without prejudice or disclaimer of the subject matter thereof, and amends claims 1, 5, 9, 10, 11, 12, 13, and 14 to more appropriately define the present invention. No new matter is introduced. Claims 1, 5, and 9-14 are pending in the application.

In the Office Action dated July 28, 2003, the Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Mano et al. (U.S. Patent No. 5,319,700) in view of Davis et al. (U.S. Patent No. 5,491,720). Applicant respectfully traverses the rejection for the following reasons.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8<sup>th</sup> ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001).

Mano discloses a terminal adapter pooling system that uses a terminal adapter to enable communications between an ISDN and a plurality of data terminals. See col. 2, lines 4-9. The system reduces a data load applied to a central control unit at the calling party signal transmission and the called party number signal reception.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
[www.finnegan.com](http://www.finnegan.com)

Davis discloses a method and system for automatically determining a data communication device type and a transmission speed associated with the data communication device type. An incoming communication is detected on a transmission line, which is connected to transmit and receive hardware. A first communication device transmits a sequence of different signals in either a first communication protocol or a second communication protocol via the transmission line. The transmission line is then monitored for a response signal sent from a second data communication device in response to receipt of a particular signal within the sequence of transmitted signals. Using the relationship between the response signal and the sequence of transmitted signals, the system determines a data communication device type and an optimal transmission speed. See col. 2, lines 17-34.

By contrast, Applicant's claims 1 and 5 recites a combination including, among other things, "a first transmitter configured to transmit a type query signal to the telephone terminal at the low speed," "a first receiver configured to receive a type signal from the telephone terminal at the low speed," "a detector configured to determine whether data is transmitted from the telephone terminal at the high speed or the low speed," and "a speed change unit configured to change a transmission speed from the high speed to the low speed when the detector determines that the data is transmitted from the telephone terminal at the low speed." Mano and Davis, taken alone or in combination, do not disclose or suggest at least these features of Applicant's claimed invention.

Additionally, there is no suggestion or motivation to modify Mano with Davis to produce Applicant's claimed invention, and such combination would not be appropriate

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
[www.finnegan.com](http://www.finnegan.com)

or effective. In particular, Davis teaches away from the present invention, disclosing that its method for establishing data communications between two modems uses "only the hardware actually required to transmit and receive data after a call is established." See col. 9, lines 4-7. Accordingly, Mano and Davis, taken alone or in combination, do not disclose or suggest at claims 1 and 5 for at least this additional reason.

Finally, the Examiner has not demonstrated a reasonable expectation of success for making the proposed combination of Mano and Davis, as required by M.P.E.P. § 2143.02. Furthermore, such teaching away, as pointed out above, further demonstrates a lack of any reasonable expectation of success. For at least the above reasons, the Examiner should withdraw the rejection of claims 1 and 5.

The Examiner's rejection of independent claims 9, 10, 12, and 14 uses the same rationale as the Examiner's rejection of claim 1 and 5. Independent claims 9, 10, 12, and 14 include recitations of a similar scope as claims 1 and 5. For example, claim 9 recites a combination including, among other things, "causing the interface unit to transmit a type query signal to the telephone terminal at a low speed," "causing the telephone terminal to change a transmission speed from the low speed to the high speed in response to the speed change request," "causing the interface unit to determine whether data is transmitted from the telephone terminal at the high speed or the low speed," and "causing the interface unit to change a transmission speed from the high speed to the low speed when it is determined that the data is transmitted from the telephone terminal at the low speed."

Claims 10 and 12 recite a combination including, among other things, "a receiver configured to receive data from the telephone terminal at the low speed" and "a detector

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
[www.finnegan.com](http://www.finnegan.com)

configured to detect whether or not the telephone terminal is capable of transmitting and receiving data at the high speed." And claim 14 recites a combination including, among other things, "a transmitter configured to transmit a type signal to the main unit at a low speed in response to a type query signal transmitted from the main unit at the low speed" and "a mode setting device configured to change a transmission speed to a high speed in response to a speed change request transmitted from the main unit."

For at least the same reasons as discussed above regarding claims 1 and 5, Mano and Davis, taken alone or in combination, fail to teach or suggest at least these exemplary features of independent claims 9, 10, 12, and 14. Accordingly, the Examiner should withdraw the rejection of independent claims 9, 10, 12, and 14 for at least this reason.

Each of dependent claims 11 and 13 depend from allowable independent claims 10 and 12, and are at least allowable based on the rationale given in the discussion above regarding the independent claims. These dependent claims disclose additional features that are neither suggested nor disclosed by Mano nor Davis, either individually, or in any reasonable combination. For at least this reason, the Examiner should withdraw the rejection of claims 11 and 13.

Finally, because Applicant has canceled claims 2-4 and 6-8 without prejudice or disclaimer of the subject matter thereof, the rejection of these claims is moot.

### CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP  
  
1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: October 28, 2003

By: Anthony J. Galante Reg. No. 53,232  
for Richard V. Burgujian  
Reg. No. 31,744

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
[www.finnegan.com](http://www.finnegan.com)